

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of
Al Mooney

Serial No.: **09/492,398**

Filed: **January 27, 2000**

For: **Method of Supplying and Dispensing
Prescribed Medical Supplies Through a Web
Site Associated with a Medical Care Provider**

Docket No: **4333-003**

PATENT PENDING

Examiner: Mr. Samuel G. Rimell

Group Art Unit: 2164

Confirmation No.: 9822

Mail Stop Appeal Brief - Patents
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September 26, 2006

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Kathy L. McDermott

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REPLY TO EXAMINER'S ANSWER MAILED JULY 26, 2006

Sir:

Applicant submits the following reply brief in response to the Examiner's Answer mailed July 26, 2006. No fees or charges should be required for entry of this reply brief. However, if any fees or charges are required for entry of this paper, the Commissioner is authorized to deduct those fees from Deposit Account 18-1167.

REMARKS

I. The Examiner Construction of “Medical Examination” is Wrong and Unsupported

The Examiner has not construed the claim term “medical examination.” The Examiner has construed the term “examination.” The question is: implicitly can one arrive at a construction for “medical examination” based on the construction of “examination” and applying a meaning for the modifier “medical”? However, the Examiner argues that there is no one construction for “medical examination.” In reality that is true for many claim terms because viewed in an ordinary sense, a claim term can have several meanings. This does not relieve the Examiner of the obligation to explicitly construe the claim term based on how it is used in the specification and how a person of ordinary skill in the art would construe the term. The Examiner simply concludes that there is no one particular construction appropriate, but that whatever the construction is the dialogue that takes place over the Internet in Silver constitutes a “medical examination.” In the end, the Examiner has not construed the claim term “medical examination” and to the extent that one can speculate on the construction given by the Examiner, the construction is wrong.

The Examiner concludes that the term “‘examination’ can be any one of [a] myriad of medial actions, including the elicitation of information for analysis, as taught be Silver.” Ex. Answer, p. 6. Thus, the construction of the term “examination” is “any one of [a] myriad of medical actions.” Parenthetically the Examiner notes that this broad construction would entail “including the elicitation of information for analysis.” The Examiner’s construction is somewhat confusing based on a following argument. After setting forth that “an examination” can be any one of a myriad of medical actions, the Examiner argues that there is no one single definition for what constitutes a medical examination. The Examiner further argues that there is no one standard, “catchall” medical examination that is known in the art and used in every instance, so the Examiner can draw from various interpretations as to what the claim term “medical examination” actually means. Ex. Answer, p. 6. It appears that the Examiner is arguing that

“medical examination” cannot be construed because it means so many different things to different people. However, it is incumbent upon the Examiner to construe the claim. That is, the Examiner must construe the term and the construction must be consistent with the specification and how a person of ordinary skill in the art would construe the term. Here, it does appear that the Examiner construed “medical examination” or at least “examination” to be any one of a myriad of medical actions. After that it is unclear as to how the Examiner actually construed the term because the Examiner, in conclusionary fashion, states:

Examiner maintains that completing the questionnaire of Silver achieves one manner of examination, from the multitude of possible examinations that are available to a medical practitioner. The examination is conducted by the provider (see fig. 2) using the medium of the website. The provider need not physically see the patient, and the specification provides no suggestion of such direct contact.

Ex. Answer, pp. 6-7.

That is not a claim construction. That is a conclusionary finding that whatever the claim construction is, the teachings of Silver fall within the scope of the claim construction.

In reality, if the Examiner has construed examination to be “any one of a myriad of medical actions” that means that the Examiner has construed “medical examination” to be any one of a myriad of medical actions taken with respect to a patient. That construction is wrong and unsupported. That construction encompasses virtually every action that is taken with respect to a patient that occurs in a doctor’s office or in a hospital. Not every action taken with respect to a patient is a medical examination.

The Examiner has an obligation to explicitly set forth a claim construction for “medical examination.” The most that could be gathered from the Examiner’s answer is that the “examination” portion of the term means any one of a myriad of medical actions. That construction, when coupled with the medical modifier, is unreasonable on its face.

The Examiner has not relied on any extrinsic evidence or medical dictionary definition to support this position. Nowhere does the Examiner show any support for whatever construction

was arrived at. Contrary to the Examiner's allegations, there is no lack of evidence as to what those skilled in the art understand that term to mean. Ballentine's Law Dictionary defines the term "medical examination" as, "An examination of a person by a physician for the purpose of giving medical treatment or medical advice. An examination by a physician to determine the state of health of the person examined, apropos the need for medical or surgical treatment" Ballentine's Law Dictionary, 3d ed. 1969, pp. 787-789 (emphasis added).

Moreover, Silver does not support the Examiner's definitions. Silver never uses the term "medical examination," much less define that term. In fact, Silver unambiguously teaches that the disclosed questionnaire does not constitute a medical examination. Figure 20 of Silver, for example, represents the recommendations provided by the questionnaire based on the user's answers (copy attached, Ex. 1). It is the Examiner's contention that this questionnaire constitutes the claimed medical examination. Note, however, that Silver explicitly states that the user should "consult [a] doctor before starting any Wellness plan." *Id.* Indeed, if the questionnaire were a medical examination as the Examiner contends, there would be no need for Silver to tell the user to "consult a doctor." The user would already be in the presence of a doctor receiving a medical examination.

It is clear that only licensed medical care providers can perform a "medical examination." Licensed medical care providers are specially trained for years to employ all of their senses to medically examine a patient and render a diagnosis. Yet, if the Examiner's contentions were accepted as true, a truck driver, a waitress, or even the Examiner, for example, merely asking someone their age or inquiring as to how they feel constitutes a "medical examination." It is undeniable that no one skilled in the art would ever understand a "medical examination" to include such scenarios. Rather, those skilled in the art would readily understand that only a doctor or other licensed medical care provider performs medical examinations.

The questionnaire in Silver propounds very general questions that require absolutely no medical expertise. All of the computer generated responses of Silver entail recommendations

that require absolutely no medical expertise, but only common sense that could be offered by any reasonably intelligent layperson. The type of questions and responses provided in Silver are in no way the type of inquiries and scrutiny that is performed by licensed medical care providers in conducting the claimed “medical examinations.”

II. The Examiner has Misconstrued the Claim Term “Prescribing”

The Examiner’s definition of the claim term “prescribing” is also unreasonable. Specifically, the Examiner asserts that Applicant’s definition of “prescribing” as “to designate or order the use of, as a remedy” matches the computer-supplied recommendations of Silver. (*Examiner’s Answer*, p. 7, ll. 10-11 (emphasis in original)). The Examiner’s interpretation of this definition, however, is based on the flawed definition of “medical examination,” and on the Examiner’s refusal to afford that term its ordinary meaning. The Examiner’s use of the term “prescribing” does not comport with the ordinary meaning of that term. Nor does Silver support such a definition.

According to its ordinary meaning, “prescribing” requires a medical examination performed by a licensed medical care provider. The positions of medical boards all over the country evidence this fact. The North Carolina Medical Board is one such entity. “No prescriptions should be issued for a patient in the absence of a documented physician-patient relationship.” See the N.C. Medical Board’s position paper for physicians entitled “WRITING OF PRESCRIPTIONS,” <http://www.ncmedboard.org/>. Thus, when Applicant defines the term “prescribing” as “to designate or order the use of as a remedy,” it necessarily means that a medical examination performed by a licensed medical care provider is required. According to the Examiner’s definition, however, the same unlicensed laymen described above that can allegedly perform a “medical examination” can also diagnose an illness, broken bones, or other medical maladies, and prescribe drugs and splints to heal them.

No one skilled in the art would ever think that anyone other than a licensed medical care provider has the power to “prescribe,” and only then after a proper medical examination has been performed. Certainly, no one skilled in the art would ever understand the computer of Silver to have the capability to “prescribe” anything. The North Carolina Medical Board supports this fact. “[P]rescribing drugs to individuals the physician has never met based solely on answers to a set of questions, as is common in Internet or toll-free telephone prescribing, is inappropriate and unprofessional.” See the N.C. Medical Board’s position paper for physicians entitled “CONTACT WITH PATIENTS BEFORE PRESCRIBING,” <http://www.ncmedboard.org/>.

Thus, the Examiner ignores Applicant’s definition of that term as well as its ordinary meaning. Moreover, Silver does not support the Examiner’s interpretation of the term “prescribing.” Silver never mentions that the computerized questionnaire provides anything other than a “recommendation.” A recommendation in any sense of that term does not mean “to designate or order the use of a remedy.” Further, the only time Silver ever broaches the subject of “prescribing” is in a context that supports Applicant. “[I]f you adhere to an exercise program as prescribed by your doctor... .” *Silver*, col. 1, ll. 56-57. It appears that even Silver recognizes what the Examiner refuses to consider – that only a licensed medical care provider can “prescribe.”

Anticipation under §102 requires the disclosure of each and every limitation of a claimed invention in a single piece of prior art. *Rockwell Intern. Corp. v. U.S.*, 147 F.3d 1358, 47 U.S.P.Q.2d 1027 (Fed. Cir. 1998). In determining if a claim is anticipated, it is fundamental that the claim first be correctly construed. That is, the scope and meaning of each contested limitation must be determined. *Gechter v. Davidson*, 116 F.3d 1454, 1457 (Fed. Cir. 1997); *In re Paulsen*, 30 F.3d 1475, 1479 (Fed. Cir. 1994). Thereafter, corresponding elements of the allegedly anticipating reference are identified. *Lindemann* at 1458. There is no anticipation unless each and every element and limitation of the claimed invention, as properly construed, is found in the single prior art reference.

Indeed, the Examiner construes the claim terms in a legally impermissible manner. The proffered definitions are unreasonable in that they warp their ordinary meanings, and are unsupported by Silver. Applicant respectfully requests that the Board take official notice that only a medical professional having a valid medical license can perform a "medical examination." The Board should also take official notice that the act of "prescribing" requires a medical examination. No one skilled in the art would ever characterize what Silver teaches as a medical examination. Nor would they characterize the resultant common-sense recommendations, which Silver teaches relate to groups of like people rather than individuals, as the act of "prescribing." Silver itself does not characterize these terms as such, and therefore, neither can the Examiner.

Silver simply fails to teach each and every element of the claims, and therefore, does not anticipate the claims under §102. Accordingly, Applicant respectfully requests that the Board overturn the rejections.

Respectfully submitted,

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Physiological Age: 46.77 Calendar Age: 46.90

Wellness Planner

Select	Recommendations*	Maximum Age Reduction (years)**	Products
<input checked="" type="radio"/>	Cigarette Smoking: Commit to stop smoking or if you already have keep up the good work.	2.75	<input type="radio"/>
<input checked="" type="radio"/>	Cholesterol and HDL: If cholesterol is high or your HDL is low reduce your dietary cholesterol, exercise and have 1 alcoholic drink a night.	1.52	<input type="radio"/>
<input checked="" type="radio"/>	Blood Pressure: Reduce your blood pressure to LESS than 120/80.	1.24	<input type="radio"/>
<input type="radio"/>	Stress: Learn methods to reduce your stress level and do them routinely.	1.22	<input type="radio"/>
<input type="radio"/>	Stamina: Do exercises that raise your heart rate to 70% of maximum ((220 minus your age) multiplied by 0.70) for 60 minutes per week.	1.13	<input type="radio"/>

with this plan:

	Physiological Age	Calendar Age
90 days from now:	43.49	47.15
3 years from now:	40.04	49.90

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*Consult your doctor before starting any Wellness plan. **Maximum age benefit in years younger if this were the only Wellness recommendation you did.

FIGURE 20

